

09-25-00

09/22/00

JC849 U.S. PTO

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REISSUE PATENT APPLICATION TRANSMITTAL

JC813 U.S. PTO

09/668952

09/22/00

Address to:

**Assistant Commissioner for Patents
 Box Reissue
 Washington, DC 20231**

Attorney Docket No. 042390.P3275R

First Named Inventor A. Ira Horden

Original Patent Number 5,812,860

Original Patent Issue Date (Month/Day/Year) 09/22/1998

Express Mail Label No. EL034436815US

APPLICATION FOR REISSUE OF:
 (check applicable box)

☒ Utility Patent ☐ Design Patent ☐ Plant Patent

APPLICATION ELEMENTS

ACCOMPANYING APPLICATION PARTS

1. ☒ *Fee Transmittal Form (PTO/SB/56)
(Submit an original, and a duplicate for fee processing)
2. ☒ Specification and Claims (amended, if appropriate)
3. ☒ Drawing(s) (35 U.S.C. 113)
4. ☒ Reissue Oath / Declaration (original or copy)
(37 C.F.R. § 1.175)(PTO/SB/51 or 52)
5. Original U.S. Patent
 Offer to Surrender Original Patent (37 C.F.R. § 1.178)
☒ (PTO/SB/53 or PTO/SB/54)
 or
☐ Ribboned Original Patent Grant
☐ Affidavit / Declaration of Loss (PTO/SB/55)
6. ☒ Original U.S. Patent currently assigned?
☒ Yes ☐ No
 (If Yes, check applicable box(es))

7. ☐ Foreign Priority Claim (35 USC 119)
(if applicable)
8. ☐ Information Disclosure Statement (IDS)/PTO - 1449 ☐ Copies of IDS Citations
9. ☐ English Translation of Reissue Oath/Declaration
(if applicable)
10. ☐ *Small Entity Statement(s) ☐ Statement filed in prior application.
(PTO/SB/09-12) Status still proper and desired
11. ☒ Preliminary Amendment
12. ☒ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
13. ☐ Other:

- ☒ Written Consent of all Assignees (PTO/SB/53 or 54)
☐ 37 C.F.R. § 3.73(b) Statement ☐ Power of Attorney

***NOTE FOR ITEMS 1 & 10: IN ORDER TO BE ENTITLED TO PAY SMALL ENTITY FEES, A SMALL ENTITY STATEMENT IS REQUIRED (37 C.F.R. § 1.27), EXCEPT IF ONE FILED IN A PRIOR APPLICATION IS RELIED UPON (37 C.F.R. § 1.28).**

14. CORRESPONDENCE ADDRESS

☐ Customer Number of Bar Code Label

(Insert Customer No. or Attach bar code label here)

or ☒ Correspondence address below

Name

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Address

12400 Wilshire Boulevard, Seventh Floor

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California

Zip Code

90025

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U.S.A.

Telephone

(503) 684-6200

Fax

(503) 684-3245

Name (Print/Type)

Donna Jo Coningsby, Reg. No. 41,684

Signature

Donna Jo Coningsby

Date

09/22/00

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PTO/SB 7 (6/99)
Approved for use through 09/30/2000. OMB 0651-0035
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Complete if Known

Application Number	
Filing Date	September 22, 2000
First Named Inventor	A. Ira Horden
Examiner Name	R. Sheikh
Group/Art Unit	unknown
Attorney Docket Number	042390.P3275R

Group/Art Unit	unknown
Attorney Docket Number	042390.P3275R

FEE CALCULATION (continued)

- ### 3. ADDITIONAL FEE

Deposit
Account
Name

☒ Charge Any Additional Fees Required Under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.

- | | Large Entity | Small Entity |
|------------------------------------|---|---|
| 1. Revenue Recognition | Revenue is recognized when the performance obligation is satisfied, which is when control of the goods or services is transferred to the customer. | Revenue is recognized when the performance obligation is satisfied, which is when control of the goods or services is transferred to the customer. |
| 2. Leases | Leases are classified as either finance leases or operating leases. Finance leases are accounted for as sales, while operating leases are accounted for as rentals. | Leases are classified as either finance leases or operating leases. Finance leases are accounted for as sales, while operating leases are accounted for as rentals. |
| 3. Intangible Assets | Intangible assets are recognized when they are identifiable and have a measurable value. They are amortized over their useful life. | Intangible assets are recognized when they are identifiable and have a measurable value. They are amortized over their useful life. |
| 4. Goodwill | Goodwill is recognized as the excess of the purchase price over the fair value of the identifiable intangible assets. | Goodwill is recognized as the excess of the purchase price over the fair value of the identifiable intangible assets. |
| 5. Research and Development | Research and development costs are expensed as incurred. | Research and development costs are expensed as incurred. |
| 6. Employee Compensation | Employee compensation is recognized when the employee has performed the service. | Employee compensation is recognized when the employee has performed the service. |
| 7. Income Taxes | Income taxes are recognized when they are payable or receivable. | Income taxes are recognized when they are payable or receivable. |
| 8. Financial Instruments | Financial instruments are recognized when they are acquired or issued. | Financial instruments are recognized when they are acquired or issued. |
| 9. Derivatives | Derivatives are recognized when they are entered into. | Derivatives are recognized when they are entered into. |
| 10. Other | Other items are recognized when they are incurred or realized. | Other items are recognized when they are incurred or realized. |

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet.	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for response within first month	
116	380	216	190	Extension for response within second month	
117	870	217	435	Extension for response within third month	
118	1,210	218	680	Extension for response within fourth month	
128	1,850	228	925	Extension for response within fifth month	
119	300	219	150	Notice of Appeal	
120	300	220	150	Filing a brief in support of an appeal	
121	260	221	130	Request for oral hearing	
138	1,510	138	1510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,210	241	605	Petition to revive - unintentional	
142	1,210	242	605	Utility issue fee (or reissue)	
143	430	243	215	Design issue fee	
144	580	244	290	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	240	126	240	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	790	246	395	Filing a submission after final rejection (37 CFR 1.129(a))	
149	790	249	395	For each additional invention to be examined (37 CFR 1.129(b))	
Other fee (specify)				Reissue filing fee	690.00
Other fee (specify)					

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
101	690	201	345	Utility filing fee	
106	310	206	155	Design filing fee	
107	480	207	240	Plant filing fee	
108	690	208	345	Reissue filing fee	
114	150	214	75	Provisional filing fee	

(\$)

Extra

		Claims	below	Fee Paid
Total Claims	21	- 20 = 1	X 18.00 =	\$18.00
Independent Claims	7	- 3 = 4	X 78.00 =	\$312.00
Multiple Dependent				

****or number previously paid, if greater, For Reissues, see below**

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
103	18	203	9	Claims in excess of 20
102	78	202	39	Independent claims in excess of 3
104	260	204	130	Multiple Dependent claim, if not paid
109	78	209	39	**Reissue independent claims over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent

(\$)	330.00
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Complete (if applicable)

Req. Number	41.684
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Date	09/22/00
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Deposit Account	02-2666
User ID	

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Express Mail Label No. EL034436815US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue Application No.: Not Yet Assigned

Filed: Concurrently herewith

Patent No.: 5,812,860

Granted:

Patentee: A. Ira Horden, et al.

Title: METHOD AND APPARATUS PROVIDING MULTIPLE VOLTAGES AND
FREQUENCIES SELECTABLE BASED ON REAL TIME CRITERIA TO CONTROL POWER
CONSUMPTION

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

REQUEST FOR ABSTRACT OF TITLE

1. Please prepare a certified Abstract of Title in respect of the above identified original patent for placing in the official file of the Reissue Application which is filed herewith.

2. Title in the name of INTEL CORPORATION
was recorded on February 12, 1996, Reel 7862, Frame 0492.

2. For the fee required by 37 CFR 1.19 (b)(4) please

- ☒ find enclosed a check in the amount of \$25.00.
☒ charge any shortages or credit any overages to Account No. 02-2666.
A duplicate of this request is attached.
☐ Charge Account No. 02-2666 in the amount of \$15.00.
A duplicate of this request is attached.

Date: 9/24/2000

Donna Jo Cohingsby
Donna Jo Cohingsby
Reg. No. 41,684

Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Boulevard
7th Floor
Los Angeles, California 90025-1026
(503) 684-6200

Reissue 09/668,952 (US Pat No. 5,831,860)


1. You required a supplemental declaration. None has been submitted.
2. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178. (FP 14.05.01)
3. By cancelling all the new claims and not amending any old ones there is no longer any error. Can not have a "no error" reissue.

Reject all the claims.

In response, Applicant

- a. can abandon the case! (and retain the original patent)
- b. Can file an RCE to continue prosecution of all the claims (i.e., amend to add back in the ones he wants)
- c. If divisional has been filed, we can suspend this case until such time as there are allowable claims in the divisional. At that point, we will rejoin the claims from the 2 applications and issue a single reissue patent.

Please return this note and include the parent cases (when submitting the action for review) to expedite the review process. If you have any questions call me. Thank You.


Pinchus M. Laufer
SPRE, TC 2100
PK2 2D-16 B
306-4160
May 28, 20021

Please remember to wand all cases (particularly the issued parent) so they can be located.

a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture.

REISSUE TO TAKE ADVANTAGE OF 35 U.S.C. 103(b):

A patentee may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b), without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). **This is not to be considered a recapture.** The addition of process claims, however, will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the “article” claims) must have been made as a result of error without deceptive intent. The addition of these “article” claims will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

REJECTION BASED UPON RECAPTURE:

Reissue claims which recapture surrendered subject matter should be rejected using form paragraph 14.17.

¶ 14.17 Rejection, 35 U.S.C. 251, Recapture

Claim[1] rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

[2]

Examiner Note

In bracket 2, the examiner should explain the specifics of why recapture exists, including an identification of the omitted/broadened claim limitations in the reissue which provide the “broadening aspect” to the claim(s), and where in the original application the narrowed